

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: HANSEN <i>et al.</i>	Docket No. 366929-018US (396515)
Serial No. 10/776,934	Group Art Unit: 1635
Filed: February 10, 2004	Confirmation No. 2105
For: OLIGOMERIC COMPOUNDS FOR THE MODULATION OF SURVIVIN EXPRESSION	Examiner: Kimberly Chong

**APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR
RECONSIDERATION UNDER 37 CFR § 1.705(b)**

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a request for reconsideration of the patent term adjustment of 0 days indicated in the determination of Patent Term Adjustment under 35 U.S.C. § 154(b) that was attached to the Notice of Allowance mailed on April 17, 2009 for the above-referenced patent application. It is respectfully requested that Applicants be granted a minimum patent term adjustment of 864 days, which may be extended or reduced based on the actual date of issuance of a patent from the above-referenced application.

The issue fee is being paid concurrently herewith.

Applicants submit herewith a "Statement Under 37 CFR §1.702(b)(2)".

In accordance with 37 CFR §1.705(b)(1), please charge the fee set forth in 37 CFR §1.18(e) (\$200.00) to Dechert LLP Deposit Account No. 50-2778 (**Order no. 366929-018US (396515)**).

Applicants kindly request grant of this petition.

Respectfully submitted,

Date: June 29, 2009

Anna D. DiGabriele
Anna D. DiGabriele
Reg. No. 59,933

DECHERT LLP
Customer No. 37509
Telephone: 650.813.4800
Facsimile: 650.813.4848

15043503.1.BUSINESS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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For:	OLIGOMERIC COMPOUNDS FOR THE MODULATION OF SURVIVIN EXPRESSION	Examiner:	Kimberly Chong

STATEMENT UNDER 37 CFR § 1.705(b)(2)

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This statement is respectfully submitted in support of the “Application for Patent Term Adjustment Including Request for Reconsideration Under 37 CFR § 1.705(b)” for the above-referenced patent application. In view of the following, it is respectfully requested that Applicants be granted a minimum patent term adjustment of 864 days, which may be extended or reduced based on the actual date of issuance of a patent from the above-referenced application.

The patent term adjustment on the Determination of Patent Term Adjustment Under 35 U.S.C. §154(b) that was attached to the Notice of Allowance (submitted herewith as Exhibit A) is 0 days. That determination projected that the patent would issue on the Tuesday before the date that is 28 weeks after April 17, 2009, the mailing date of that notice (*i.e.*, October 27, 2009). A copy of the Office’s calculation of 0 days, printed from PAIR, is submitted herewith as Exhibit B.

This determination of 0 days is in error for the following reasons: (1) the PTO’s miscalculation of the 4 Month Delay incurred by the Office in its Non-final Office Action mailed on April 17, 2007; and (2) the miscalculation of overlap of the delays under 37 CFR §§ 1.702(a) and 1.703(a) and the delays under 37 CFR §§ 1.702(b) and 1.703(b). *See Wyeth v. Dudas*, 88 U.S.Q.P. 2d 1538 (D.D.C. 2008).

A. 14 Month Delay and 4 Month Delay under 37 CFR §§ 1.702(a) and 1.703(a)

1. 14 Month Delay

Applicants are entitled to a period of patent term adjustment pursuant to 37 CFR §§ 1.702(a)(1) and 1.703(a)(1) ("14 Month Delay"). Applicants agree with the Office's calculation shown in Exhibit B that the 14 Month Delay is 101 days. Because the Office failed to mail an action under 35 U.S.C. §132 until July 20, 2005, Applicants are entitled to a period of patent term adjustment beginning on the day after the date that is 14 months after the date on which the above-referenced application was filed under 35 U.S.C. §111(a), *i.e.*, February 11, 2004, and ending on the date of mailing of an action under 35 U.S.C. §132, *i.e.*, July 20, 2005, or 101 days.

2. 4 Month Delay

Applicants are entitled to a period of patent term adjustment pursuant to 37 CFR §§ 1.702(a)(2) and 1.703(a)(2) ("4 Month Delay"). Applicants disagree with the Office's calculation shown in Exhibit B that the 4 Month Delay is 0 days. Applicants respectfully submit that the correct 4 Month Delay is 332 days. The relevant facts are as follows:

1. On January 20, 2006, Applicants filed a reply under 37 CFR § 1.111 including a response to restriction requirement.
2. On September 19, 2006, the Office mailed a notice to comply with requirements for patent applications containing nucleotide sequence and/or amino acid sequence disclosures.
3. On March 15, 2007, Applicants filed a response to the notice to comply with requirements for patent applications containing nucleotide sequence and/or amino acid sequence disclosures.
4. On April 17, 2007, the Office mailed a non-final office action **in response to the January 20, 2006 response to restriction requirement**. See Exhibit C (cover page and office action summary from April 17, 2007)

In its PTA calculation, the Office mistakenly assumed that the April 17, 2007 office action was in response to Applicants' March 15, 2007 response to the notice to comply, and thus calculated the 4 Month Delay as 0 days. Instead, Applicants are entitled to a period of patent term adjustment of 332 days due to the failure by the Office to mail an action under 35 U.S.C. §132 not later than four months after the date of Applicants' reply under 37 CFR § 1.111 of January 20, 2006 (*i.e.*, May 20, 2006). Because the Office failed to mail an action under 35 U.S.C. §132 until April 17, 2007, Applicants are entitled to a period of patent term adjustment beginning on the day after the date that is four months after the date a reply under 37 CFR § 1.111 was filed (*i.e.*, January 21, 2006) and ending on the date of mailing of an action under 35 U.S.C. §132 (*i.e.*, April 17, 2007) or 332 days.

Accordingly, the total period of patent term adjustment under 37 CFR §§ 1.702(a) and 1.703(a) is 101 days of 14 Month Delay plus 332 days of 4 Month Delay for a total of 433 days.

B. 3 Year Delay under 37 CFR §§ 1.702(b) and 1.703(b)

Applicants are entitled to a period of patent term adjustment pursuant to 37 CFR §§ 1.702(b) and 1.703(b) due to examination delay equal to the number of days in the period beginning on the day after the date that is three years after February 10, 2004, when the above-referenced application was filed under 35 U.S.C. §111(a) (*i.e.*, February 11, 2007) and ending on the date a patent is issued, not including several categories of exceptions stated in 35 U.S.C. § 254(b)(1)(B)(i)-(iii) ("3 Year Delay"). Applicants agree with the Office's calculation shown in Exhibit B that the 3 Year Delay is 990 days, based on a projected issue date of October 27, 2009.

C. Exclusion of Overlapping Delay under 37 CFR § 1.703(f)

Applicants are not entitled to a period of patent term adjustment to the extent that the periods in 37 CFR § 1.702 (*i.e.*, the 14 Month Delay, the 4 Month Delay and the 3 Year Delay) overlap pursuant to 37 CFR §1.703(f) ("Overlapping Delay"). Applicants disagree with the Office's calculation of Overlapping Delay of 101 days. As the period of 4 Month Delay ended on April 17, 2007, and the 3 Year Delay began February 11, 2007, Applicants submit that these periods overlap by 66 days. See *Wyeth v. Dudas*, 88 U.S.P.Q. 2d at 1541. To calculate the period of patent term adjustment, the total period of examination delay is thus to be reduced by the sum of the period of overlap, *i.e.*, 66 days.

D. Exclusion of Applicant Delay under 37 CFR §§ 1.703(f) and 1.704

Applicants are not entitled to a period of patent term adjustment to the extent that they failed to engage in reasonable efforts to conclude prosecution of the application pursuant to 37 CFR §§ 1.703(f) and 1.704 (“Applicant Delay”).

Applicants agree with the Office’s calculation shown in Exhibit B that the Applicant Delay is 92 days with respect to the response filed by Applicants on January 20, 2006. The Applicant Delay is the number of days beginning on the day after the date that is three months after the date of mailing of the July 20, 2005 Office Action (*i.e.*, October 21, 2005) and ending on the date the reply was filed (*i.e.*, January 20, 2006), which is 92 days.

Applicants agree with the Office’s calculation shown in Exhibit B that the Applicant Delay is 158 days with respect to the Response filed June 27, 2006. Applicants’ response filed on January 20, 2006 to the Office Action mailed July 20, 2005 was deemed by the Office to be non-compliant. Applicants therefore incurred further Applicant delay beginning on the day after the non-compliant reply was filed (*i.e.*, January 21, 2006) and ending on the day that Applicants filed a compliant response to the Office Action mailed July 20, 2005 (*i.e.*, June 27, 2006), which is 158 days.

Applicants agree with the Office’s calculation shown in Exhibit B that the Applicant Delay is 86 days with respect to the response filed by Applicants on March 15, 2007. The Applicant Delay is the number of days beginning on the day after the date that is three months after the date of mailing of the September 19, 2006 Office communication (*i.e.*, December 20, 2006) and ending on the day the reply was filed (*i.e.*, March 15, 2007), which is 86 days.

Applicants agree with the Office’s calculation shown in Exhibit B that the Applicant Delay is 87 days with respect to the response filed by Applicants on October 12, 2007. The Applicant Delay is the number of days beginning on the day after the date that is three months after the date of mailing of the April 17, 2007 Office Action (*i.e.*, July 18, 2007) and ending on the day the reply was filed (*i.e.*, October 12, 2007), which is 87 days.

Applicants agree with the Office’s calculation shown in Exhibit B that the Applicant Delay is 50 days with respect to the response filed by Applicants on May 28, 2008. The Applicant Delay is the number of days beginning on the day after the date that is three months after the date of mailing of the January 8, 2008 Office Action (*i.e.*, April 9, 2008) and ending on the day the reply was filed (*i.e.*, May 28, 2008), which is 50 days.

Applicants disagree with the Office's failure to calculate any delay with respect to the amendment filed by Applicants pursuant to 37 C.F.R. § 1.312 on May 1, 2009. The Applicant Delay is the number of days beginning on the day that the amendment was filed (*i.e.*, May 1, 2009) and ending on the mailing date of the Office response to the amendment (*i.e.*, May 20, 2009), which is 20 days.

Accordingly, the total period of Applicant Delay under 37 CFR §§ 1.703(f) and 1.704 is 493 days.

E. Total Patent Term Adjustment

Pursuant to 37 CFR § 1.703(f), the total patent term adjustment is 433 days of 14 Month Delay and 4 Month Delay, plus 990 days of 3 Year Delay, minus 66 days of Overlapping Delay, minus 493 days of Applicant Delay, for a total of 864 days.

F. Conclusion

In view of the foregoing, it is respectfully requested that this Application for Patent Term Adjustment be favorably considered and that a corrected Determination of Patent Term Adjustment be issued to reflect a patent term adjustment of 864 days, which may be extended or reduced based on the actual date of issuance of a patent for the above-referenced application.

Respectfully submitted,

Date: June 29, 2009

DECHERT LLP
Customer No. 37509
Telephone: 650.813.4800
Facsimile: 650.813.4848


Anna D. DiGabriele
Reg. No. 59,933

Exhibit A

Copy of "Determination of Patent Term Adjustment under 35 U.S.C. § 154(b)



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P O Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,934	02/10/2004	Bo Hansen	366929-018US (396515)	2105
37509	7590	04/17/2009	EXAMINER CHONG, KIMBERLY	
DECHERT LLP P.O. BOX 390460 MOUNTAIN VIEW, CA 94039-0460			ART UNIT 1635 PAPER NUMBER	
DATE MAILED: 04/17/2009				

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 0 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 0 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

Exhibit B

Printout of PTA Calculation from PAIR

07-20-2005	Mail Restriction Requirement	101
07-19-2005	Requirement for Restriction / Election	+
05-11-2005	IPW TSS Processing by Tech Center Complete	+
05-11-2005	Cases Documented to Examiner in CAU	+
07-14-2004	Preliminary Amendment	+
02-03-2005	Information Disclosure Statement (IDS) Filed	+
02-03-2005	Information Disclosure Statement (IDS) Filed	+
12-16-2004	Reference capture on IDS	+
12-16-2004	Information Disclosure Statement (IDS) Filed	+
12-16-2004	Information Disclosure Statement (IDS) Filed	+
09-20-2004	Application Return from OIPE	+
09-20-2004	Application Return TO OIPE	+
09-20-2004	Application Return from OIPE	+
09-20-2004	Application Is Now Complete	+
09-20-2004	Application Return TO OIPE	+
08-17-2004	Application Dispatched from OIPE	+
09-20-2004	Application Is Now Complete	+
07-14-2004	Payment of additional filing fee/fee/fee	+
02-10-2004	Claim Preliminary Amendment	+
07-14-2004	A set of symbols and procedures, provided to the PTO on a set of computer disques, that describe the invention.	+
07-14-2004	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant	+
07-26-2004	CRF Is Good Technically / Entered into Database	+
05-14-2004	Notice Mailed—Application Incomplete—Filing Date Assigned	+
03-30-2004	Cleared by LMR (LARS)	+
03-18-2004	Referred to Level 2 (LARS) by OIPE CSR	+
03-02-2004	IPW Scan & PACR Auto Security Review	+
02-10-2004	Initial Exam Team in	+

If you need help:

- Call the Patent Electronic Business Center at (866) 217-9197 (toll free) or e-mail EBCC@uspto.gov for specific questions about Patent Application Information Retrieval (PAIR).
- Send general questions about USPTO programs to the USPTO Contact Center (USCC).
- If you experience technical difficulties or problems with this application, please report them via e-mail to Electronic Business Support or call 1-800-796-9199.

reprints or materials you would like featured on this section by E-mail to the webmaster@uspto.gov. While we cannot promise to accommodate all requests, your suggestions will be considered and may lead to other improvements on the website.

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101	3 YEARS	14 MONTHS	EVENT	4-MONTH DELAY	4-MONTH DELAY	3-MONTH DELAY	2-MONTH DELAY	1-MONTH DELAY	0-MONTH DELAY
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TOTALS

101 332 710 66 713

NET =

$$101 + 332 + 990 - 66 - 493 = 864 \text{ DAYS}$$

Exhibit C

Summary of Office Action mailed April 17, 2007
(first 2 pages only)



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/776,934

02/10/2004

Bo Hansen

58610 (71432)

2105

21874

7990

04/17/2007

EDWARDS ANGELL PALMER & DODGE LLP

P.O. BOX 55874

BOSTON, MA 02205

EXAMINER

CHONG, KIMBERLY

ART UNIT

PAPER NUMBER

1635

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/776,934

Applicant(s)

HANSEN ET AL.

Examiner

Kimberly Chong

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3.5-16, 19-21, 23-38, 45, 46, 48-52, 120-124 and 153-169 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 3.5-16, 19-21, 23-38, 45, 46, 48-52, 120-124 and 153-169 is/are rejected.
 7) ☒ Claim(s) 23-38, 48 and 50 is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 10 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 7/14/04, 12/16/04
 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
 5) ☐ Notice of Informal Patent Application (PTO-152)
 6) ☒ Other: 2/3/05, 8/29/05, 1/23/07, IDS